

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and following remarks is respectfully requested.

Claims 23-48 are pending in this application. By this amendment, Claims 23, 42 and 45 have been amended; and Claims 47 and 48 have been added. It is respectfully submitted that no new matter has been added.

In the outstanding Office Action, Claims 23, 24, 36, 37, 39 and 41 were rejected under 35 U.S.C. §102(b) as being anticipated by Graham (U.S. Patent No. 2,380,690); and Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Graham in view of Kuo (U.S. Patent No. 6,254,017 B1). Claims 25, 27-35, 38, 40 and 42-46 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Applicant acknowledges with appreciation the indication that Claims 25, 27-35, 38, 40 and 42-46 include allowable subject matter. However, since Applicant considers that amended Claim 23 patentably defines over the cited references, Claims 25, 27-35, 38, 40 and 42-46 have been maintained presently in dependent form.

There is no indication on the copy of the List of References cited by Applicant Form PTO-1449 attached to the present Office Action that the references have been considered. It is respectfully requested that a copy of the Form PTO-1449 along with an indication that the references have been considered be appended to the next Official Communication.

Claim 23 recites:

placing a deformable sealing ring around the male
thread;

thereafter engaging the free end of the male element;
and

screwing the male thread into the female thread, the
sealing ring, during the screwing, being pushed along the male

screwing the male thread into the female thread, the sealing ring, during the screwing, being pushed along the male element by the first shoulder, rotated by the female element and compressed radially between the male thread, into which it is pressed, and the peripheral surface of the housing.

It is respectfully submitted that these features are neither disclosed by nor rendered obvious by Graham, Kuo or the combination thereof.

The Office Action states that “placing a deformable sealing ring (14) around the male thread; engaging the free end of the male element; and screwing the male thread into the female thread, the sealing ring, during the screwing, being pushed along the male element by the first shoulder, rotated by the female element and compressed radially between the male thread into which it is pressed, and the peripheral surface of the housing (Figs. 1 and 2)” is disclosed by Graham. Applicant respectfully disagrees.

Graham describes a basic pipe joint in which an annular member 14 is radially expanded in a recess 13 in order to obtain sealing of the joint when the male and the female elements are threaded together. Graham describes in column 3, lines 39-47 “[e]ach of the annular members 14 is preferably expanded into tight engagement with the periphery of the respective recesses 13. The periphery of each of the recesses 13...has depressions or grooves formed therein so that the annular members 14 will be held securely therein and prevented from turning when the joint is assembled or disassembled.” It is apparent from the description of Graham that the annular members 14 are put in the recess 13 before the male element is inserted into the female element. Furthermore, it is apparent from the above-quoted passages that the annular members 14 are radially expanded into engagement with recess 13, at 15, and that sealing is achieved by means of this radial stress.

Graham does not describe first placing a deformable sealing ring on the male thread, and thereafter engaging the free end of the male element, and finally threaded the male thread into the female thread. Rather, the structure of Graham prevents the placement of the annular

members around the male thread and the male thread being threaded into the female thread thereafter to achieve pushing of the sealing ring along the male element during this threading.

The Office Action asserts that the patentability of product-by-process claims does not depend on its method of production, citing M.P.E.P. § 2113. M.P.E.P. § 2113 further provides:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979)

Applicant's specification at page 12, lines 18-24 states:

In addition, a portion of the volume of the ring is axially compressed between the surfaces 24 and 25, contributing to the seal and the stability of the position of the ring. The axial length of the sealing ring corresponds at least to a half-pitch of the threads, and advantageously to a small multiple of the pitch.

The description in Graham at column 4, lines 39-47 describes that the annular members are expanded into tight engagement with the periphery of the respective recesses 13 and are held securely therein and prevented from turning when the joint is assembly or disassembled. There is no description in Graham of an axial compression of annular members 14. Accordingly, it is respectfully submitted that the claim steps would be expected to impart distinctive structural characteristics to the final product neither disclosed by nor rendered obvious by Graham.

It is respectfully submitted that Kuo fails to correct the deficiencies of Graham described above in that Kuo fails to describe the claimed method steps.

It is respectfully submitted that Claims 24-48 are patentable at least for the reasons argued above with regard to Claim 23 from which they depend.

Formal corrections have been made by this amendment to FIG. 8 and the description thereof in the specification at page 13, lines 15-24. No new matter has been added.

Consequently, for the reasons discussed in detail above no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. Therefore, a notice of allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below-listed telephone number.

Respectfully submitted,

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